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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097226,794	01/07/99	DEBINSKI W	6460-4

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EXAMINER

UNGAR, S

ART UNIT

PAPER NUMBER

1642

6

DATE MAILED: 01/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/226,794

Applicant(s)

Debinski et al

Examiner

Ungar

Group Art Unit

1642



☒ Responsive to communication(s) filed on Jan 1, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-13 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-13 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Claims 1-13 are pending in the application and are currently under prosecution.

Please Note: In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

Group I. Claims 1-6 are drawn to a method of reducing the rate of growth of tumor cells in vivo classified in Class 514, subclass 2.1 and Class 435, subclass 326.

Group II. Claims 7-8 are drawn to a method of detecting an IL13-specific receptor in a tissue specimen classified in Class 435, subclass 4.

Group III. Claim 9 is drawn to a method of imaging tumor cells classified in Class 514, subclass 2.

Group IV. Claims 10-11 are drawn to a pharmaceutical composition comprising an IL13 receptor-binding moiety and a cytotoxic moiety, classified in Class 424, subclass 1.11.

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Group V. Claim 12 is drawn to a kit comprising an IL13 receptor-binding moiety classified in Class 435, subclass 810.

Group VI. Claim 13 is drawn to a polynucleotide classified in Class 536, subclass 23.1

3. The inventions are distinct, each from the other because of the following reasons:

Inventions IV-VI as disclosed are biologically and chemically distinct, unrelated in structure and function, made by and used in different methods and are therefore distinct inventions.

Inventions I-III are materially distinct methods which differ at least in objectives, method steps, reagents and/or dosages and/or schedules used, response variables, and criteria for success.

The inventions of Groups IV and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (i) the process for using the product as claimed can be practiced with another materially different product or (ii) the product as claimed can be used in a materially different process of using that product [see *MPEP* § 806.05(h)]. In the instant case the IL-13/cytotoxic moiety product as claimed can be used in a materially different process such as affinity chromatography.

The inventions of Groups IV and II/III are not at all related because the moiety of Group IV is not used in any of the methods of Groups II/III.

The inventions of Groups V and I-III are not at all related because the moiety of Group V is not used in any of the methods of Groups I-III.

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The inventions of Groups VI and I-III are not at all related because the moiety of Group VI is not used in any of the methods of Groups I-III.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Group I is further subject to election of a single disclosed species.

Claim 1 is generic to a plurality of disclosed patentably distinct species comprising methods of treatment with different outcomes wherein (a) the rate of tumor growth is inhibited (claim 4), (b) tumor volume is reduced (claim 5).

6. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R.

§ 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

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8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

9. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (703) 305-2181. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310. The fax phone number for this Art Unit is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

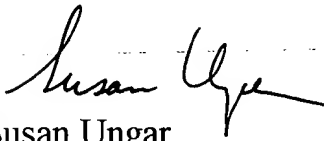
Effective, February 7, 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this

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application, all further correspondence regarding this application should be directed to Group Art Unit 1642.

A handwritten signature in black ink, appearing to read "Susan Ungar". The signature is fluid and cursive, with a long horizontal stroke at the end.

Susan Ungar

Primary Patent Examiner

December 29, 1999



RESTRICTION ELECTION FACSIMILE TRANSMISSION

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